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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,569	05/31/2001	Robert J. Feilbogen	702984	3485
23460 7590 07/09/2008 LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6731				
EXAMINER				
BORLINGHAUS, JASON M				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/871,569

**Applicant(s)**

FEILBOGEN ET AL.

**Examiner**

JASON M. BORLINGHAUS

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 15-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/02)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1—12, 15, 19 – 33 and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Boesch (US Patent 5,897,621) in view of Mancini (US Patent 7,024,383).

**Regarding Claim 1**, Boesch discloses a computerized method for monitoring business transactions to provide foreign currency exchange hedging instructions and to provide foreign currency price information for goods of commerce, comprising the steps of:

- receiving by a hedging processor (server) business transaction information regarding including purchases or sale of goods by a

customer (customer computer or merchant computer). (see col. 3, line 50 – col. 4, line 17);

- receiving hedging rules (instructions) from the customer and set by the customer, wherein said hedging rules (instructions) define a user-specified event (acceptable “risk range”) that triggers the hedging processor to initiate (approves) an exchange a first type of currency (customer selected currency A) to a second type of currency (merchant selected currency P) on the customer’s behalf. (see col. 7, lines 30 – 59; col. 9, lines 11 – 52);
- receiving pricing rules (instructions) from the customer (customer computer) and set by the customer, wherein said pricing rules define a second user-specified event (request) that triggers the hedging processor to provide updated public foreign currency prices (exchange rate) of said goods. (see col. 11, lines 23 – 43);
- generating by the hedging processor (server) public price information (exchange rate data) to provide foreign currency prices of said goods to the customer, based on said pricing rules (business rules) and based on public price information provided by a plurality of foreign exchange (FX) rate providers (one or more currency brokers). (see col. 8, line 49 – col. 9, line 3; col. 11, lines 6 – 43);
- generating by the hedging processor (server) hedging instruction information to provide instructions (approval/disapproval) on whether to exchange from said first type of currency to said second type of

currency, based on said hedging rules (predetermined criteria) and the occurrence of the first user-defined event (acceptable "risk ranges). (see col. 9, lines 4 – 52);

- forwarding the hedging instruction information (data) to one of the plurality of FX rate providers (currency broker, bank or financial institution). (see col. 14, lines 2 – 14);
- receiving, by the one of the plurality of FX rate providers (currency broker, bank or financial institution), an amount of currency of the first type. (see col. 14, lines 2 – 14);
- exchanging (converting), by the one of the plurality of FX rate providers (currency broker, bank or financial institution) in response to receiving the hedging instruction information (data), currency of the first type of currency of the second type. (see col. 14, lines 2 – 14); and
- paying an amount of currency of the second type into an account of the customer (merchant account). (see col. 10, lines 45 – 64).

Boesch does not explicitly teach a method wherein the business transaction information regarding a plurality of business transactions including purchases or sales of goods by a customer (emphasis added), although Boesch does limit itself to selling only one item or only performing one iteration of the disclosed methodology.

Mancini discloses a method for monitoring business transactions for providing to provide foreign currency exchange hedging (risk management) instructions and to provide foreign exchange information for goods of commerce,

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comprising the steps of receiving by a hedging processor business transaction information regarding a plurality of business transactions (aggregated transactions) including purchases or sales of goods by a customer. (see abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Boesch by incorporating the ability to handle a plurality of business transactions, as disclosed by Mancini, rather than handling a solitary business transaction, allowing the system to handle multiple business transactions.

**Regarding Claims 2 - 5,** Boesch discloses a method:

- wherein said transaction information is received via at least one transaction data stream (transmission of transaction amount), wherein said public price information is generated as at least one price data stream (exchange rate data), and wherein said hedging instruction information (approval/disapproval) is generated as at least one hedging instruction data stream. (see col. 7, lines 40 – 47; col. 8, lines 49 – 58; col. 9, lines 4 – 52);
- further comprising the step of receiving, from one of the plurality of FX rate providers or a foreign exchange liquidity provider (currency broker, bank or financial institution), market rate information (exchange rate data) having current market foreign exchange rates (updated exchange rate data), including rates for exchanging said first type of

currency to said second type of currency and vice-versa. (see col. 8, line 49 – col. 9, line 3);

- wherein said step of generating said public price information (displayed exchange rate data displayed to customer) is further based on the received market rate information (exchange rate data received from currency broker, bank or financial instrument). (see col. 8, line 49 – col. 9, line 3; col. 11, lines 6 – 43); and
- wherein said market rate information (exchange rate data) is received via at least one market rate data stream. (see col. 8, line 49 – col. 9, line 3).

**Regarding Claims 6 – 9, Boesch discloses a method:**

- wherein said pricing rules (business rules) further define when to update said foreign currency prices (exchange rate data) of said goods, based on at least one of after the expiration of a predetermined time interval (frequency and timing of updates is based on business rules). (see col. 8, line 49 – col. 9, line 3);
- wherein said pricing rules (business rules) further define rules to update said foreign currency prices (exchange rate data) of said goods, based on either the actual current market rate (exchange rate data) or said actual current market rate adjusted by a predetermined amount. (see col. 8, line 49 – col. 9, line 3);
- wherein said hedging rules (programming) further define when to exchange said first and second types of currency, based on at least

one of when the current market rate deviates from the market rate information by at least a first predetermined percent (fluctuations in exchange rate). (see col. 9, lines 11 – 51); and

- wherein said hedging rules (programming) further define an amount to exchange said first and second types of currency, based on either a total accumulated revenue (aggregated transactions) of said first type of currency. (see col. 8, lines 49 – 58).

**Regarding Claims 10 – 12, Boesch discloses a method:**

- wherein said steps of generating said public price information and generating said hedging instruction information are performed by the hedging processor in a computerized system (server). (see col. 3, line 50 – col. 4, line 17);
- wherein said computerized system (server) is configured within at least one of a local network (see col. 3, line 50 – col. 4, line 17); and
- wherein said computerized system is configured within an application service provider (server), remote from said customer (connected to merchant/customer computer via network). (see col. 3, line 50 – col. 4, line 17).

**Regarding Claims 15, Boesch discloses a method:**

- wherein the plurality of FX rate providers include a multi-bank website, an individual bank website, a non-bank website offering a live market foreign exchange rate stream and an exchange service based on said



price stream, or any combination thereof (currency broker, bank or financial institution). (see col. 14, lines 2 – 14); and

**Regarding Claims 19 – 33 and 37**, such claims recite substantially similar limitations as claimed in previously rejected claims, Claims 1 – 12 and 15, and would have been obvious based upon previously rejected claims.

**Claims 16 – 18 and 34 – 36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Boesch and Mancini, as applied to Claims 1 and 20above, and further in view of Pool (US Patent 6,460,020).

**Regarding Claims 16 – 17**, Boesch does not explicitly teach a method wherein said transaction data stream is received from a business-to-business (B2B) portal, wherein said B2B portal is a medium to allow said customer to buy or sell said goods; nor wherein said B2B portal is at least one of an online marketplace, a vendor website, a purchaser website, or any combination thereof. However, Boesch does disclose a method wherein said transaction data stream is received from a merchant and a customer connected to the Internet, wherein said Internet is a medium to allow said customer to buy or sell said goods (as customer shops over the network), and such a portal would be an online marketplace. (see fig. 1; col. 13, lines 5 – 27).

Pool discloses a method wherein said transaction data stream (electronic purchase orders) is received from a business-to-business (B2B) portal (an electronic catalog stored on a publicly accessible database), wherein said B2B portal is a medium (internet/intranet) to allow said customer to buy or sell said

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goods (ordering system); and wherein said B2B portal is at least one of an online marketplace (electronic merchandise catalogue and ordering system for use on the internet/intranet). (see col. 1, lines 9 – 49).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Boesch and Mancini by incorporating a B2B portal, as disclosed by Poole, allowing for a hedging methodology that oversees business transactions to be incorporated into a portal that enables the conducting of business transactions.

**Regarding Claim 18**, Boesch discloses a method:

- further comprising the step of forwarding the hedge instruction data streams (approval/disapproval) and the public price data streams (exchange rate data) as an electronic ticket (data) to at least one of said customer. (see col. 11, lines 49 – 64; col. 13, lines 35 – 60).

**Regarding Claims 34 - 36**, such claims recite substantially similar limitations as claimed in previously rejected claims, Claims 16 - 18, and would have been obvious based upon previously rejected claims.

### ***Response to Arguments***

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

### **Monitoring Business Transactions and Hedging**

The preamble of Claim 1 discusses "monitoring business transactions" and the first claim limitation of Claim 1 states that the hedging processor receives "business transaction information regarding a plurality of business transactions including purchases or sales of goods by a customer." Examiner assumes that the Applicant intends the "hedging" methodology is being performed to reduce the risk of traditional business transactions (i.e. purchasing and selling).

However, there is no language within the claims that appears to tie the "hedging" performed together with the "business transactions" being monitored. The claimed language merely states that the method is for "monitoring business transactions", that the processor receives "business transaction information" and "hedging" is taking place.

Additionally, the Applicant constantly utilizes the term "hedging". Hedging, traditionally, describes an investment made in order to reduce the risk of adverse price movements in securities or currencies, in which a party takes an offsetting position in a related security or currency, such as an option or a short sale.

However, the claim language utilized by the Applicant to describe the step-by-step methodology of "hedging" appears to be merely to be describing a currency exchange.

Examiner just wants to make Applicant aware of these points, as they have arisen when discussing the instant application with primaries and SPEs within my practice area.

### ***Conclusion***

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON M. BORLINGHAUS whose telephone number is (571)272-6924. The examiner can normally be reached on Monday - Friday; 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on (571)272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason M Borlinghaus/  
Examiner, Art Unit 3693

July 7, 2008

/James P Trammell/  
Supervisory Patent Examiner, Art Unit 3694